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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/531,578	04/18/2005	Yasushi Uchida	123521	1842
25944	7590	09/20/2007	EXAMINER	
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320				KEMMERLE III, RUSSELL J
ART UNIT		PAPER NUMBER		
		1731		
MAIL DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/531,578	UCHIDA ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Russell J. Kemmerle	1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 30 July 2007.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 9-16 is/are pending in the application.
  - 4a) Of the above claim(s) 13-16 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 9-12 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 18 April 2005 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date: _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>See Continuation Sheet</u> | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|   | 6) <input type="checkbox"/> Other: _____                          |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :18 April 2005; 29 June 2005; 05 July 2006; 18 July 2007.

## DETAILED ACTION

### *Election/Restrictions*

Applicant's election with traverse of claims 9-12 in the reply filed on 30 July 2007 is acknowledged. The traversal is on the ground(s) that the subject matter of all claims is sufficiently related that a thorough search for the subject matter of any one group of claims would encompass a search for the subject matter of the remaining claims, and thus would not constitute a serious burden. This is not found persuasive because claims 9-12 are drawn to method of producing a honeycomb structure without regard for the exact properties of the final structure produced, while claims 13-16 are drawn to a honeycomb structure without regard to the method of how it is made. Therefore a search of the different groups would involve extensive searching in non-overlapping areas, as claims 9-12 require a search in the areas involving a method of making a honeycomb structure, while a search of claims 13-16 would require a search through areas involving a honeycomb body

It should be noted, that claims 13-16 are product-by-process claims, and as such, determination of patentability is based on the product formed, and is not limited to products formed by the process described. See *In re Thorpe*, 777 F.2d 695, 698; 227 USPQ 964, 966 (Fed. Cir. 1985) ("[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the

prior art, the claim is unpatentable even though the prior product was made by a different process." (Citations omitted)

The requirement is still deemed proper and is therefore made FINAL.

***Priority***

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 12 recites a limitation with respect to "the component". There is insufficient antecedent basis for this limitation in the claim.

The phrase "a total mass of the component occupies 50% by mass or more with respect to a total mass of the aggregate particle material" renders claim 12 further indefinite, because it is not clear what the applicant intends for that phrase to mean. If the component is meant to refer to the honeycomb body formed, or the mixture used to form the honeycomb body, it would not be possible for that to occupy only 50 mass% of the aggregate particle material which is but one component of that mixture. For the purpose of this Office Action, it was assumed that what was meant was that the

aggregate particle material is at least 50 mass% of the total mass of the mixture created.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 9-12 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 7-10 of copending Application No. 10/531,873. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications disclose a method of forming a porous honeycomb body by mixing and kneading at least an aggregate particle material of a ceramic and/or metal, water, and organic binder, and a pore former to form a clay, which is shaped, dried, calcined and fired. They further both recite the use of silicon and/or a non-oxide ceramic containing silicon (such as silicon

carbide or nitride), and further the same amount of alkali metal source being added to the mixture

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 9-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Beall (WO 01/16,049).

Beall discloses a method of forming a ceramic honeycomb body involving kneading a mixture of magnesium oxide, aluminum oxide and silicon oxide (i.e., an aggregate particle material), with an organic binder system including water. This mixture is then formed into a honeycomb shaped green body, dried and fired (the firing process would inherently involve also calcining the body since it is fired at a temperature above the calcining temperature of such a body) (claim 1).

Beall further discloses that the silica could be in the form of colloidal silica (page 8 lines 8-9).

While Beall does not specifically disclose an additive put in specifically for the purpose of forming pores, the organic binder added would burn out during firing, and thus would act to form pores in the final body.

Referring to claim 10, Beall discloses that the silica (which can optionally be in the form of colloidal silica) be in an amount of at least 5% by weight of the inorganic raw material mixture (aggregate particle material) (claim 4).

Referring to claim 11, Beall further discloses adding 0.2-2 parts by weight of sodium stearate (an alkali metal source) based on 100 parts by weight of the aggregate particle material (page 9 lines 17-21).

Referring to claim 12, Beall includes teachings that the aggregate material include alumina as discussed above. Further, Beall teaches that the mixture created include the aggregate material in an amount of at least 50% by mass (page 9 lines 9-21, based on the amount of additives disclosed being less than 50% by mass).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell J. Kemmerle whose telephone number is 571-272-6509. The examiner can normally be reached on Monday through Friday, 8:30-4:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/RJK/

  
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